

The opinion in support of the decision being  
entered today is not binding precedent of the Board.

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Paper

Filed by: Interference Trial Section Merits Panel  
Box Interference  
Washington, D.C. 20231  
Tel: 703-308-9797  
Fax: 703-305-0942

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

ARNOLD C. BILSTAD, BRADLEY H. BUCHANAN,  
ALAN W. MARTILLA and ARCHIE WOODWORTH  
Junior Party,  
(Application 09/294,964),

v.

GEORGE WAKALOPULOS and  
EDUARDO R. URGILES

Senior Party  
(Patent 6,140,657).

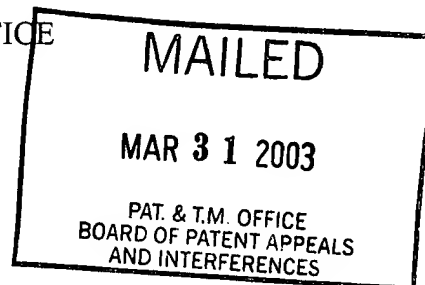
Patent Interference No. 104,832

Before: SCHAFER, TORCZON and NAGUMO, Administrative Patent Judges.

SCHAFER, Administrative Patent Judge.

**DECISION ON WAKALOPULOS' PRELIMINARY MOTION 1  
AND FINAL JUDGMENT**

Wakalopulos filed a preliminary motion asserting that all of Bilstad's involved claims (Claims 57-65) are unpatentable under 35 U.S.C. § 112, ¶ 1, for failing to be supported by a written description. Paper 21. We grant the motion. Since Bilstad's Claims 57-65 formed the sole basis



for declaring this interference with Wakalopulos' claims and are new matter in the Bilstad application, Bilstad lacks standing to prosecute this interference. We therefore enter final judgment against Bilstad.

## **FINDINGS OF FACT**

The following findings are supported by a preponderance of the evidence. Additional findings are made in the Analysis section of this opinion.

### **Background**

1. This interference was declared March 30, 2002, between Bilstad Application 09/294,964 and Wakalopulos Patent 6,140,657.
2. Bilstad provoked the interference by filing an amendment adding claims 57-65 which were copies of or based upon certain claims of the Wakalopulos patent. Bilstad Application 09/294,964, Paper 15, p. 13.
3. The interference was declared with a single count with Bilstad Claims 57-65 (the copied claims) designated as corresponding to the count. The remaining Bilstad claims (1-17 and 34-56) were designated as not corresponding to the Count and are not involved in this interference. Paper 1, p. 5.
4. During a conference call on May 24, 2002, Wakalopulos proposed filing a preliminary motion asserting that Bilstad's Claims 57-65 were unpatentable under 35 U.S.C. § 112, ¶ 1. Paper 19, p. 2.
5. Because the motion was potentially dispositive, filing of the motion, opposition and reply and cross-examination of witnesses were expedited. Papers 19, p. 2; Paper 23, pp. 1-2; Paper 29, p.1.
6. A separate schedule was set for the filing of other authorized preliminary motions. Paper 19, p. 6 (Appendix).
7. Wakalopulos filed Wakalopulos Motion # 1 (Paper 21) on June 17, 2002.

8. Bilstad has not filed a preliminary motion seeking to amend any of Bilstad's claims or designate any additional Bilstad claims as corresponding to the count for the purpose of avoiding the asserted unpatentability under 35 U.S.C. § 112, ¶ 1.<sup>1</sup>
9. An oral hearing was held on Wakalopulos Motion # 1 on September 27, 2002.
10. After the oral hearing, further submission of papers was terminated. Paper 60.

**The subject matter of Bilstad's involved claims**

11. Bilstad's involved claims are directed to an apparatus used for sterilizing objects. Bilstad Application 09/294,964, Paper 15, p. 13.
12. The apparatus includes "a moveable member." Bilstad Application 09/294,964, Paper 15, p. 13.
13. The claims characterize the moveable member as "manipulating objects in a plurality of directions . . . ." Bilstad Application 09/294,964, Paper 15, p. 13.

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<sup>1</sup> Bilstad filed the following preliminary motions:

1. Bilstad Preliminary Motion 1 seeking to add a new Claim 66 to the Bilstad application. Proposed Claim 66 includes the same limitation asserted by Wakalopulos to be lacking descriptive support in Bilstad's involved claims. Paper 31
2. Bilstad Preliminary Motion 2 seeking to substitute a count. Paper 32.
3. Bilstad Preliminary Motion 3 seeking to designate certain of Wakalopulos non-corresponding claims as corresponding to the count. Paper 33.

Granting of any of Bilstad's preliminary motions would not affect our decision on Wakalopulos Preliminary Motion No. 1.

<sup>2</sup> Bilstad Claims 57-64 and all of Wakalopulos claims include the following somewhat peculiar limitation: "a moveable member manipulating objects in a plurality of directions within the reactive volume . . . ." We say the limitation is peculiar since it appears from the language as written that in order to meet this limitation the moveable member would have to be in the act of manipulating an object in a plurality of directions. However, the parties are in agreement that the limitation should be understood to be a moveable member "capable of" manipulating objects. Without deciding whether this is an appropriate construction of the claims and for the purpose of this decision only, we adopt the parties' construction. But this interpretation raises potential questions of its own as to whether the limitation is a means plus function limitation subject to the required statutory construction of 35 U.S.C. § 112, ¶ 6, notwithstanding the lack of the word "means" in the claims. See Micro Chemical, Inc. v. Great Plains Chemical Co., 194 F.3d 1250, 1257, 52 USPQ2d 1258, 1263 (Fed. Cir. 1999); Al-Site Corp. v. VSI Int'l, Inc., 174 F.3d 1308, 1318, 50 USPQ2d 1161, 1166 (Fed. Cir. 1999) (A claim element may be a "means plus function" element under the statute notwithstanding the failure to recite the word "means" if such an element nonetheless relies on functional terms rather than structure or material to describe performance of the claimed function.) The parties argue that the limitation should not be construed as subject to the provisions of the § 112, ¶ 6. Paper 47, p. 1; Paper 49, pp. 9-10. However, since the limitation does not specify any structure, and, according to the parties, should not be construed under § 112, ¶ 6, the limitation raises the question of whether it is improper as a "conveniently functional limitation at the exact point of novelty" under Halliburton Oil Well Cementing Co. v. Walker, 329 U.S. 1, 71 USPQ 175 (1946). It is not, however, necessary to resolve these questions in deciding Bilstad's Preliminary Motion 1.

14. Bilstad independent Claims 57, 62 and 65 are reproduced below:

57. A sterilization apparatus comprising, an electron beam tube having a window permitting emergence of an electron beam from said tube into an ambient gaseous environment while preserving a vacuum environment in the tube, the electron beam having a trajectory within a plasma cloud defining a reactive volume stimulated by interaction of the electron beam with the ambient environment, with a beam energy less than 100 kV at the target, and a moveable member manipulating objects in a plurality of directions within the reactive volume wherein the manipulated objects are sterilized.

62. A sterilization apparatus comprising, a chamber with ports allowing insertion of objects to be sterilized and having a gaseous environment therein, a plurality of vacuum tubes fixed relative to the chamber, each emitting an electron beam along a path into the chamber through a window separating the gaseous environment of the chamber from the vacuum of the tube, the beam paths from the tubes within a common plasma cloud stimulated by the electron beams interacting with the gaseous environment within the chamber, defining a volume associated with the plasma cloud wherein the objects to be sterilized are exposed to the plasma cloud, and at least one moveable member manipulating objects in a plurality of directions in the reactive volume wherein manipulated objects are sterilized.

65. A sterilization apparatus comprising, a single electron beam tube having a window permitting emergence of an electron beam from said tube into an ambient gaseous environment while preserving a vacuum environment in the tube, the electron beam having a trajectory within a plasma cloud defining a reactive volume stimulated by interaction of the electron beam with the ambient environment, with a beam of energy less than 100 kV at the target, and an automated moveable member for manipulating objects, including objects that differ in variety, size and shape from the objects to which they are joined, in a plurality of directions within the reactive volume wherein the manipulated objects are sterilized by said single electron beam tube.

Bilstad Application 09/294,964, Paper 15, pp. 4-5 (emphasis added).

#### **Wakalopulos' Motion**

15. Wakalopulos asserts that all of Bilstad's involved claims are unpatentable under 35 U.S.C. § 112, ¶ 1, because the specification does not provide a written description of the subject matter of those claims.

16. Wakalopulos' argues that the phrase "moveable member manipulating objects in a plurality of directions within the reactive volume wherein the manipulated objects are sterilized" is not described in Wakalopulos' specification. Paper 21, p. 6.
17. Wakalopulos says
- [i]t is generally understood that the expression "moveable member manipulating objects" refers to any device or apparatus capable of moving or manipulating objects.
- Paper 21, p. 6.
18. Wakalopulos does not provide any evidence supporting the alleged general understanding.
19. Wakalopulos also argues that "plurality of directions" means a multitude of directions. Paper 21, pp. 6-7.
20. In Wakalopulos' view the Bilstad application only describes linear or unidirectional manipulation of objects, not manipulation in a multitude, i.e. "a plurality," of directions. Paper 21, pp. 7-11.
21. In response, Bilstad identifies various portions of the specification said to provide descriptive support for the limitation. Paper 28, p. 6, ¶ 6.
22. With particular reference to Bilstad Figures 1, 2 and 3A-3D, and 5A-5D Bilstad argues that these figures along with the corresponding portions of the specification describing the figures demonstrate a specific embodiment of the invention:
- These different Figures are interrelated, and together illustrate members manipulating objects in a plurality of directions within an e-beam field."
- Paper 28, p. 8 (emphasis added).
23. Bilstad argues that plurality means "two or more." Paper 28, p. 6, ¶ 4.
24. Bilstad argues that the Bilstad specification shows an apparatus which manipulates objects in three directions which is said to be a "plurality of directions." Paper 28, pp. 8-11.
25. As part of the argument, Bilstad accepts the meaning of "moveable member manipulating objects" asserted by Wakalopulos:

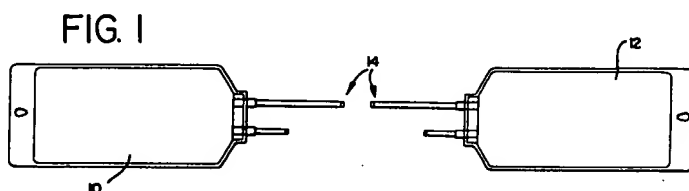
Wakalopulos argues that this language is "generally understood" to mean "... any device or apparatus capable of moving or manipulating objects [Emphasis added]." (Wak. Motion 1, page 6, first line of second full paragraph). Accepting this definition, Bilstad can show disclosure for a

device or apparatus—including a surface, a mechanism, and the like—which is capable of moving or manipulating—including bringing, transporting, supporting, cutting, and other such operations—an object.

Paper 28, pp. 11-12.

### **Bilstad's Written Description**

26. The word “plurality” does not appear in Bilstad's written description. The only place the word appears in Bilstad's specification is in the claims added to provoke this interference.
27. Bilstad specifically refers to Figures 1, 2, 3A-3D, 5A-5B, 6A-6D, 8A-8D and 9 and the following portions of the written description (B. Ex.<sup>3</sup> 2006) as providing written descriptive support for the “plurality of directions” limitation: Page 4, lines 20-24; Page 5, lines 7-8; lines 9-10; Page 6, lines 21-22; lines 24-25; lines 28-29; Page 7, lines 2-4; line 5; line 19; lines 21-22; lines 23-25; lines 25-27; Page 8, lines 6-8; lines 8-10; lines 11-12; lines 12-14; lines 16-21, lines 21-23; Page 9, lines 28-30; Page 10, lines 4-7; lines 8-9; lines 9-11. Paper 28, p. 6, ¶ 6.
28. Bilstad's Figure 1 depicts two components, 10 and 12, situated opposite each other to be cut and joined at ends 14 forming a sterile joint.<sup>4</sup>
29. Bilstad Figure 1 is reproduced below:



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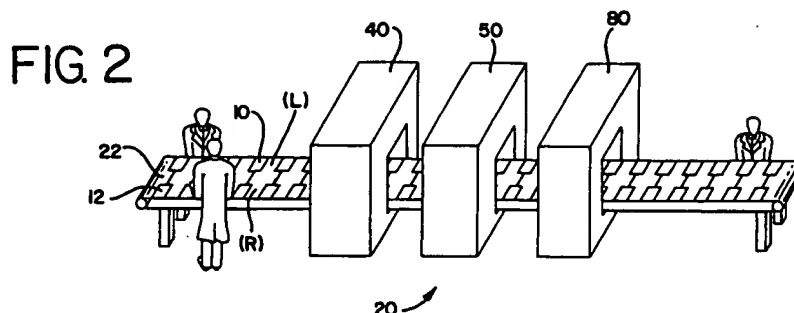
<sup>3</sup> “B. Ex. means Bilstad Exhibit.

<sup>4</sup> Bilstad's written description describes this procedure as follows:

One embodiment may have a mechanism which severs the ends of the pre-sterilized components while supported by the surface in the active sterile field to create open ends, as well as a mechanism which brings the opened ends into aligned contact with each other while supported by the surface in the active sterile field. The apparatus is completed by a sealing device 5 which joins the opened ends together.

B. Ex. 2006, p. 4, ll. 21-25

30. Bilstad's Figure 2 is said to depict an assembly line to be used for sterile joining of components 10 and 12.<sup>5</sup> B. Ex. 2006, pp. 6-7.
31. Bilstad's Figure 2 is reproduced below:



32. Bilstad's Figure 3 is said to show components 10 and 12 moving towards each other and the formation of a sterile joint within the reactive volume.<sup>6</sup> B. Ex. 2006, p. 7, ll. 5-27.

<sup>5</sup> The complete description of Bilstad's Figure 2 follows:

FIGURE 2 illustrates a general assembly line production concept for a sterile joining system 20. Such a mass production system, it is anticipated, would provide many benefits throughout the industry. Components 10, 12 are shown spaced along the sterile joining system 20 at various stages of the process. FIGURE 2 shows the sterile joining system 20 comprised of a support surface 22 extending the length of the system. This surface, when divided lengthwise, has a left half (L) and a right half (R). Components 10, 12 are shown arranged in pairs on support surface 22, with component 10 along the left side (L) of surface 22 and component 12 along the right side (R). The support surface 22 may be a conveyor belt, or similar moving surface, to automatically transport components 10, 12 through the system 20. Sterile filling using a bulk 30 container may use only a single line of empty components, as will be more fully understood later in this disclosure.

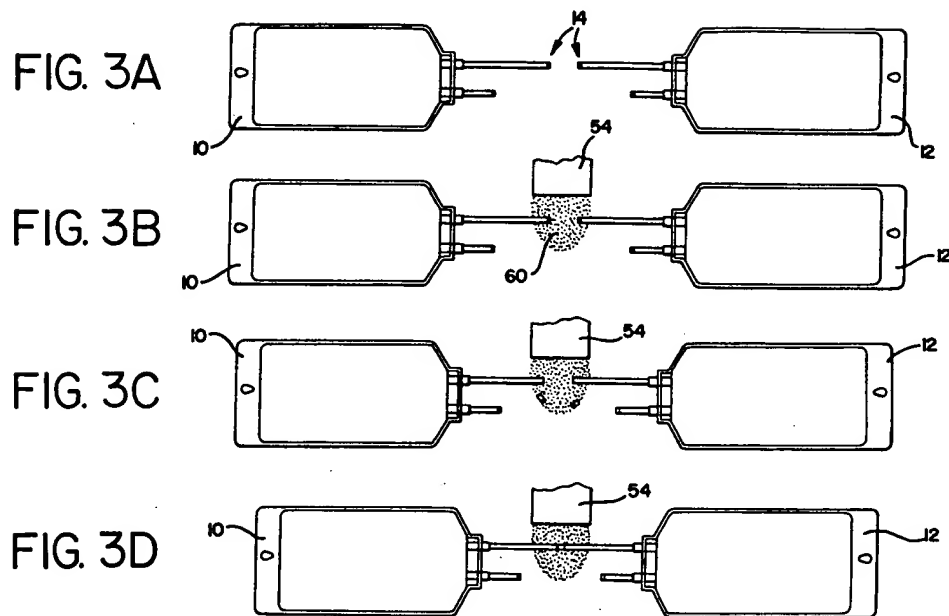
The arranged components 10, 12 are first optionally conveyed to a labeling station 40 where important batch, lot, and date codes may be applied. Components 10, 12 are then conveyed to the active sterile field station 50 where a sterile connection between the pre-sterilized components may be effected. This process is better illustrated in FIGURES 3A and 3B.

B. Ex. 2006, p. 6, l. 21 - p. 7, l. 4.

<sup>6</sup> Bilstad describes Figures 3A-3D as follows:

FIGURES 3A - 3D show an electron beam (e-beam) field 60 created within station 50. Electron beam 60 is created by the tube 54 as illustrated in FIGURE 4. Tube 54 comprises a vacuum tube 55 shrouding filament 56 on all sides, except at base 57. Base 57 has various electrical connectors 58 for plugging into a low voltage source. Opposite base 57 is a thin film window 59 which discharges the electron beam toward the desired location. Window 59 is approximately 3 microns thick, and through it a beam of approximately 2 mm x 25 mm. (0.08" x 1") area is discharged. Arrays of tubes 54 could be set up to increase the collective area of the e-beam discharge. An example of this arrangement is illustrated in U.S. Patent No. 5,414,267 (or Re. 35,203) to Wakalopoulos, the disclosure of which is hereby

33. Bilstad's Figures 3A-3D are reproduced below:



34. Figures 3A - 3D shows separate components 10 and 12, each moving in a single direction towards the other.

incorporated by reference.

Tube 54 is preferably about 5 cm (2") from the area in which an active sterile field is desired and operates at about 60 KeV. Higher voltages may allow a greater gap, and a lower voltage might require a lesser gap. FIGURE 3A shows the pre-sterilized components 10, 12 arranged prior to connection. Tube 54 creates the spherical-shaped e-beam field 60 having approximately a two-inch diameter. Other diameters of the sterile field are certainly possible, however manipulation of the joining of components requires very little space. Where a greater space is required, field 60 could be made larger by conventional methods.

Referring to FIGURE 3B, the ends 14 of components 10, 12 are conveyed into the sterile e-beam field 60. While maintained within sphere 60, ends 14 of each component 10, 12 may be cut-off, as shown in FIGURE 3C, to create opened ends. The mechanism for opening these ends may be a mechanical blade, which may be held permanently within the e-beam field 60 to maintain its sterility, or any other suitable cutting or opening mechanism. FIGURE 3D shows that once the ends 14 are cut-off, the resulting open ends are connected together while still within the field 60.

B. Ex. 2006, p. 7, ll. 5-27.



35. Figures 5A and 5B are said to show clamps 70 and 71 which may be used to support and bring together multiple components 10 and 12 for joining of ends 14 in a reactive volume to make a sterile joint.<sup>7</sup> B. Ex. 2006, p. 5, ll. 7-10, p. 8, ll. 6-21.
36. Bilstad's Figures 5A and 5B are reproduced below:

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<sup>7</sup> Bilstad's brief description of Figures 5A and 5B as well as the detailed description of each are reproduced:

FIG. 5A is one embodiment of a mechanism for supporting the ends of multiple components within an active sterile field;

FIG. 5B shows the mechanism of FIG. 5A as the ends of multiple components are brought into contact with each other within an active sterile field . . . .

B. Ex. 2006, p. 5, ll. 7-10.

Connection of the opened ends together while still within the e-beam field 60 may be achieved in a variety of ways. FIGURES 5A and 5B illustrate one possible mechanism for bringing the opened ends into aligned contact with each other. The mechanism uses a pair of automated clamps 70, 71 which engage a portion of components 10, 12, respectively, just behind ends 14, as shown in FIGURE 5A. Clamps 70, 71 close about components 10, 12 by actuation in the direction of arrows (A,B). Clamps 70, 71 have a pair of rotating tabs 72, 73 which help to maintain the alignment of ends 14 of components 10, 12. Upon rotation of tabs 72, 73 in the direction of arrows (C,D), ends 14 of components 10, 12 are exposed within the e-beam field (See FIGURE 3B) from tube 54. A short delay of approximately 2-3 seconds allows the e-beam to sterilize the surface of the ends 14 before they are opened.

The type of connection to be made will determine how the opened ends of components 10, 12 are brought into contact with one another. FIGURES 5A and 5B illustrate the use of a spike tube and a membrane tube. With the spike and membrane configuration, cut-off of the ends 14 is not necessary. After the short delay to allow for surface sterilization, clamps 70, 71 may be actuated in the direction of arrows (E,F). The spike tube is designed to pierce the membrane tube and continue to enter the membrane tube until actuation is complete.

B. Ex. 2006, p. 8, ll. 6-21.

FIG. 5A

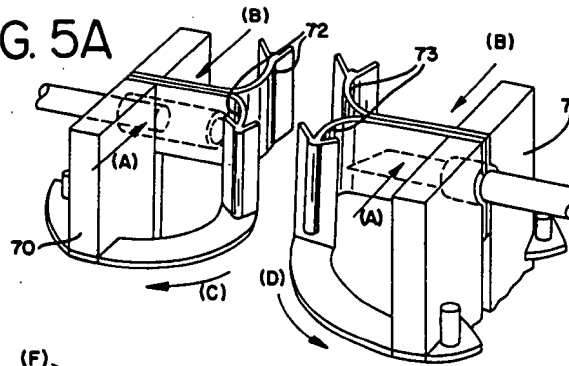
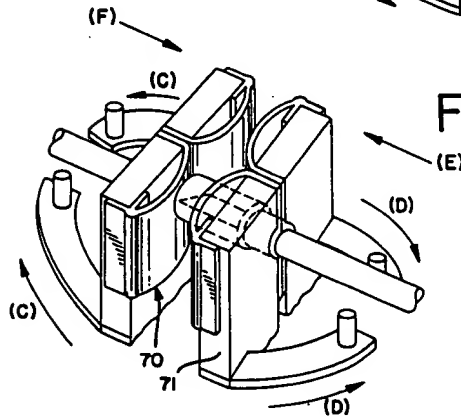


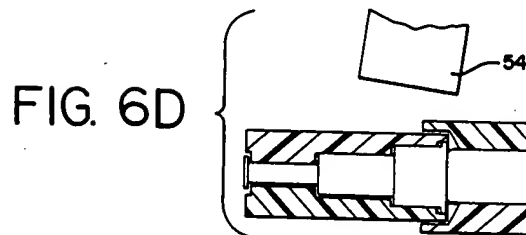
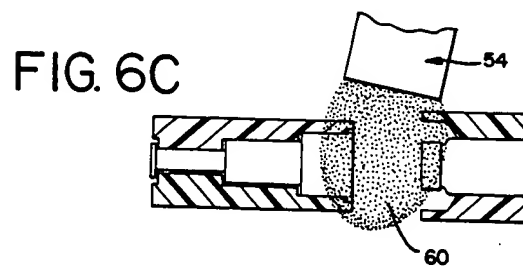
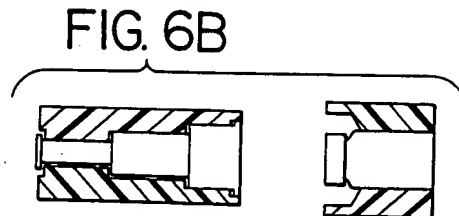
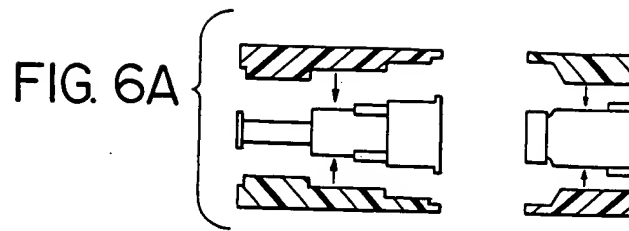
FIG. 5B



37. Figures 5A and 5B show each clamp moving in a single direction designated by the arrows (E) and (F) in Figure 5B.
38. Bilstad's Figures 6A-6D are said to illustrate a technique for sterile assembly of two components.<sup>8</sup> B. Ex. 2006, p. 8, ll. 22-23.
39. Bilstad's Figures 6A-6D are shown below:

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<sup>8</sup> Bilstad's specification describes Figures 6A and 6D as follows:  
 FIGURES 6A-6D illustrate a device to vial sterile assembly (as opposed to a sterile connection) using a variation of the disclosed method.  
 B. Ex. 2006, p. 8, ll. 22-23.



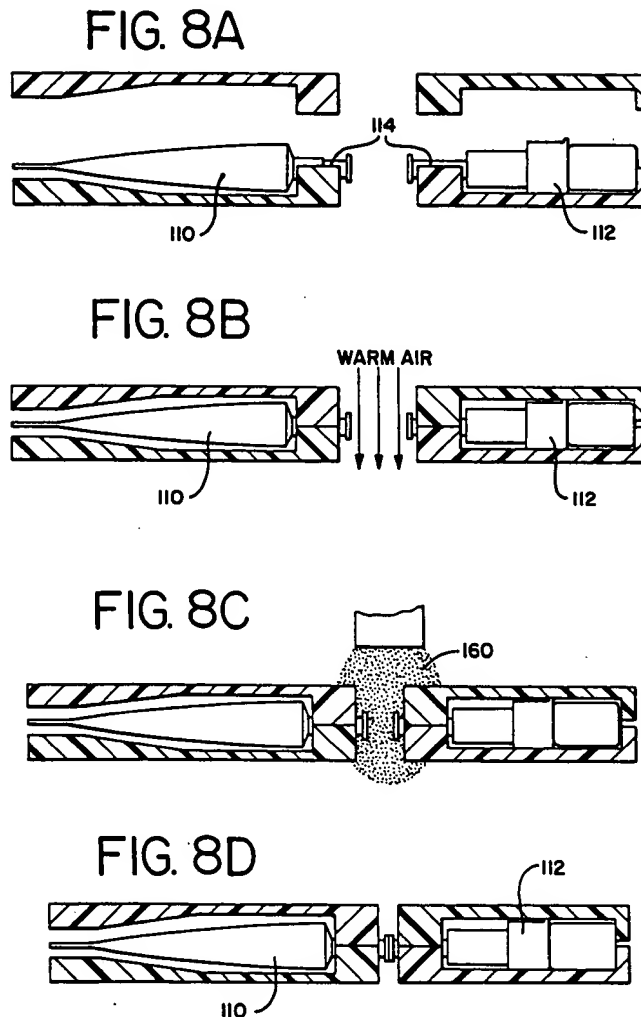
40. Figures 6A-6D show two separate components each moving in a single direction towards the other.
41. Bilstad Figures 8A-8D are said to show another technique for assembling two components 110 and 112.<sup>9</sup> B. Ex. 2006. p. 9, ll. 24-30.

<sup>9</sup> Bilstad's specification describes Figures 8A-8D as follows:

In an alternate method, shown in FIGURES 8A-8D, a device to vial assembly (similar to the assembly shown in FIGURE 6D) connection is illustrated with some variation to the methods previously discussed. FIGURE 8A shows device 110 and vial assembly 112, both having membrane tubes 114, positioned for sterile connection. The membrane tube 114 of each becomes semi-amorphous, and the tubes 114 are moved toward one another, as shown in FIGURE 8C, within e-beam field sphere 160.

B. Ex 2006, p. 9, lines 24-30.

42. Bilstad's Figures 8A-8D are reproduced below:



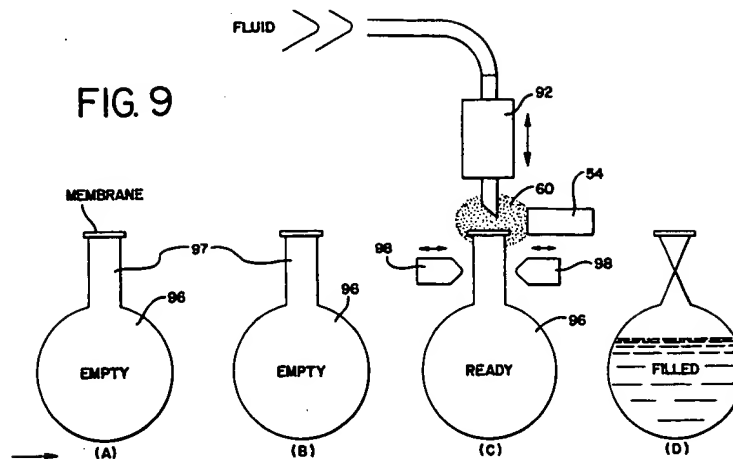
43. Bilstad's Figures 8A-8D show two separate components 110 and 112 each moving in a single direction towards each other to be assembled.
44. Bilstad's Figure 9 is said to depict a sterile fill process using a piercing valve 92 to fill container 96.<sup>10</sup> B. Ex. 2006, p. 10, ll. 1-13.

<sup>10</sup>

Bilstad's specification provides the following description of Figure 9:

Another variation is shown in the sequenced illustration of FIGURE 9, in which the present invention is used for a sterile fill process. A bulk fluid container (not shown) preferably has a piercing valve of some type, generally illustrated as 92, for dispensing a pre-sterilized liquid within held within the container. While maintaining valve 92 within an

45. Bilsted's Figure 9 is reproduced below:



46. The double-headed arrow shown to the right of piercing valve 92 indicates that the piercing valve may move vertically towards or away from the container 96.
47. Bilstad's Figure 9 depicts a piercing valve 92 capable of moving in two directions, towards or away from container 98.

#### The Colgate Testimony

48. Bilstad relies on the testimony of Prof. J. Edward Colgate. Paper 28, p. 7, ¶ 8.
49. Prof. Colgate's testimony expresses the opinion that the Bilstad specification describes a device or apparatus moving objects in a plurality of directions. B. Ex. 2009, p. 4, ¶ 6.

active sterile field 60, empty pre-sterilized containers 96 having an inlet port 97 covered preferably by a thin membrane (not shown) may be positioned, as shown at points (A) and (B), to travel toward the dispensing valve 92 of the container to receive an aliquot of sterile liquid. Upon reaching the dispensing valve 92, as shown at point (C), the inlet port 97 and membrane are held within the sterile field 60 aligned with dispensing valve 92 to effect sterilization of the outer surfaces. Then, dispensing valve 92, having a spiked end, moves to pierce or breach the membrane of inlet port 97 within sterile field 60, and filling may begin. Inlet port 97 is maintained within sterile field 60 until the pre-sterilized container 96 is sufficiently filled. Inlet port 97 may then be sealed by sealer 98 and removed from the sterile field 60, as shown at point (D).

B. Ex. 2006, p. 10, ll. 1-13.

50. In reaching this conclusion, Prof. Colgate adopts the meaning of “moveable member manipulating objects” proffered by Wakalopoulos as meaning any device or apparatus capable of moving or manipulating objects. B. Ex. 2009, p. 4, ¶ 5.

51. Prof. Colgate does not testify that this is the meaning that a person having ordinary skill in the art would give to the phrase “moveable member manipulating objects.”

52. With respect to Figures 3A-3D and page 7, lines 16-27 of Bilstad’s specification Prof. Colgate testifies:

Figures 3A-3D and page 7 lines 16-27 describe a device for making a sterile connection of two components within a sterile field. The device serves to sterilize the component ends, cut off those ends to form open ends, and then join the open ends. This device is capable of manipulating objects, including cutting off component ends, and moving those ends toward one another along a common axis.

B. Ex. 2009, p. 2.

53. With respect to Figures 5A and 5B and page 8, lines 7-15, Prof. Colgate testifies:

Figures 5A and 5B and page 8, lines 7-15 describe an apparatus for performing a sterile joint of multiple components within a sterile field. The device serves to hold the component ends, peel away a protective covering from each end, align the ends, and join the ends. This device is capable of manipulating objects, including peeling away a protective covering from a pre-sterilized component, aligning two components, and moving two components toward one another.

B. Ex. 2009, p. 3.

54. With respect to Figures 6A-6D, and the portion of the specification describing those drawings Prof. Colgate testifies:

Figures 6A-6D and page 8, lines 22-26 describe an apparatus for performing a sterile assembly (as opposed to connection) of two components. This device is capable of manipulating objects, including those motions necessary for assembly

B. Ex. 2009, p. 3.

55. With respect to Figures 8A-8D and the descriptive portion of the Bilstad specification Prof. Colgate testifies:

Figures 8A-8D and page 9, lines 24-31 describe another apparatus for performing a sterile assembly of two components. The device serves to hold

the two components, sterilize the ends of the components, heat up the ends until they become semi-amorphous, assemble the two ends, then hold the two ends together until they cool enough to form a seal. This device is capable of manipulating objects, including moving two objects toward one another along a common axis.

B. Ex. 2009, p. 3.

56. With respect to Figure 9 and the description at page 10, lines 1-13, of the Bilstad specification Prof. Colgate testifies:

Figure 9 and page 10, lines 1-13 describe an apparatus for performing a sterile fill of a pre-sterilized container with a pre-sterilized liquid. This device is capable of manipulating objects, including moving one object toward another to puncture a seal and establish a sterile connection, and sealing a container subsequent to a sterile fill.

B. Ex. 2009, p. 3.

57. With respect to the limitation "a moveable member manipulating objects in a plurality of directions within the reactive volume" Prof. Colgate testifies:

5. I have been asked to comment on whether the '964 application describes a device (or apparatus) moving (or manipulating) objects in a plurality of directions while the objects are in the reactive volume (electron beam field). In arriving at my conclusions, I have relied upon the following definitions: "Moveable member manipulating objects" refers to any device or apparatus capable of moving or manipulating objects; "Plurality" means two or more.

6. I have concluded that the '964 application does describe a device (or apparatus) moving objects in a plurality of directions while the objects are in the reactive volume (electron beam field). This conclusion is supported by a number of facts and analyses that will now be reviewed.

7. As I mentioned previously in paragraph 3, Figure 2 and page 6, line 21 through page 7, line 4 describe an assembly line apparatus for mass production of the sterile joining technique. The conveyor belt shown in Figure 2 is clearly capable of moving objects along a single direction. Normally, it would move objects through the reactive volume, which is fixed relative to the assembly line, as illustrated in Figure 2. Moreover, the term "conveyor belt" normally refers to a continuously moving surface, as opposed to "indexing table," which refers to a surface that starts and stops. Thus, it would be clear to one skilled in the art that the conveyor belt illustrated in Figure 2 is capable of moving objects while those objects are in the reactive volume.

8. As illustrated in Figure 2, however, the components to be joined or assembled are normally arranged such that the motion required for joining or assembly is perpendicular to the motion imparted by the conveyor belt. Thus, Figures 3, 5, 6, and 8, each of which illustrates a joining or assembly operation, necessarily show a second direction of motion in which objects may be moved while in the reactive volume. In each of these figures, the conveyor as well as the mechanism responsible for the joining or assembly motion have been suppressed in order to focus attention on the sequence of steps which enable sterile connection to occur. Nonetheless, the existence of these motions, as well as mechanisms that create them, would be obvious to one skilled in the art.

9. In addition to the two axes of motion (conveyance in and out of the reactive field and joining/assembling along a perpendicular axis) that are present in the systems illustrated in Figures 3, 5, 6 and 8, several other examples of distinct axes of motion may also be recognized in the '964 application.

10. One such example is given on page 8, lines 11-12 which describe "a pair of rotating tabs 72, 73 which help to maintain the alignment of ends 14 of components 10, 12," and also in claim 46 which describes "a mechanism which brings the opened ends into aligned contact with each other while in the active sterile field." These two examples describe mechanisms or devices for alignment. The Random House Dictionary defines "align" as "to arrange in a straight line," or "to bring into a line." The point is that, whereas the main joining or assembly motion may occur along a single line, it is necessary to provide additional axes of motion so that the components may be moved to that line. This concept is well-known to experts in robotics and automated manufacturing. Williams, for instance, in his book "Manufacturing Systems: an Introduction to the Technologies," discusses the problems of jamming and wedging that may occur in parts mating due to angular and off-axis misalignment. Williams goes on to describe a device, the remote center compliance, often used in automated systems to bring objects into correct alignment. Of course, many other techniques are known in the art for establishing proper alignment. Similar discussions can be found in the books by Asfahl and Sandler referenced above. In conclusion, by describing mechanisms capable of alignment, the '964 application inherently describes mechanisms capable of moving objects along a plurality of axes.

11. Figures 5A and 5B illustrate another type of complex motion involving a plurality of axes. In Figure 5A, tabs 72 and 73 are shown enclosing the sterile ends of the two components to be joined. These tabs are "peeled" away by means of the rotary motion shown with arrows C and D in both Figures



5A and 5B, thereby exposing the sterile ends within the reactive field. As these tabs are peeled away, the two exposed ends are moved toward one another (arrows E and F) to form a connection. The combined peeling and joining motion imparted on the tabs is, of course, quite complex, involving translation along two axes as well as rotation and bending (deformation) of the tabs. This is clearly an example of a mechanism imparting motion along a plurality of axes within a reactive field.

12. Figures 3 and 9 illustrate yet another type of complex motion involving a plurality of axes. In particular, these two figures illustrate situations in which a component is permanently deformed. In Figure 3, the ends of two components are cut off prior to joining, and in Figure 9 a container is sealed subsequent to filling. These cutting and sealing operations clearly involve motion along axes perpendicular to the principal joining/assembling axis. Although these operations do not involve gross displacement of components, they do involve motion via deformation. In this sense, they result in motion along a plurality of axes.

13. In conclusion, I believe that there are several respects in which motion along a plurality of directions within the reactive volume is described in the '964 application. These include:

- a. Motion imparted by the conveyor of Figure 2 combined with joining/assembling motion as illustrated in Figures 3, 5, 6 and 8.
- b. (a) combined with additional motions necessary to bring components into alignment.
- c. (a) combined with additional motions necessary to "peel" away protective tabs.
- d. (a) combined with additional motions necessary to permanently deform (cut or seat) components.

14. Also in conclusion, I believe that one skilled in the field of automated assembly would recognize immediately, upon reading page 3, lines 18-23, that "assembling the ends together" would in many instances involve a plurality of directions, even in the absence of any further discussion. The fact of the matter is that assembly often requires motion along multiple directions. Even an action as simple as screwing the lid onto a jar involves both rotation and translation.

B. Ex. 2009, pp. 4-7, ¶¶ 5-14.

## Written Description

58. In its ordinary meaning, “plurality” refers to a range of a number of objects beginning with two and otherwise being unbounded. It is a generic term which connotes from as few as two to a large number of objects.
59. The relied upon portions of Bilstad’s written description relating to Bilstad Figures 1-8 describe a member capable of manipulating or moving objects at best in a small number of directions.
60. Bilstad’s written description does not provide support for the full scope of the phrase “a moveable member manipulating objects in a plurality of directions within the reactive volume wherein the manipulated objects are sterilized.”

## ANALYSIS

Wakalopulos asserts that Bilstad involved claims, Claims 57-65, are unpatentable under 35 U.S.C. § 112, ¶ 1, because those claims are not supported by a written description in Bilstad’s involved application.

### I.

A purpose of the written description requirement is to prevent an applicant from later asserting that he invented that which he did not; the applicant for a patent is therefore required to “recount his invention in such detail that his future claims can be determined to be encompassed within his original creation.” Amgen Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1330, 65 USPQ2d 1385, 1397 (Fed. Cir. 2003) quoting Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1561, 19 USPQ2d 1111, 1115 (Fed. Cir. 1991) (citation omitted). Satisfaction of this requirement is measured by the understanding of the ordinarily skilled artisan. Amgen, 314 F.3d at 1330, 65 USPQ2d at 1397; Lockwood v. American Airlines, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997) (“The description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.”).

While it is legitimate to amend claims or add claims to a patent application purposefully to encompass devices or processes of others, there must be support for such amendments or additions in the originally filed application. PIN/NIP, Inc. v. Platte Chemical Co., 304 F.3d 1235, 1247, 64 USPQ2d 1344, 1352 (Fed. Cir. 2002); Kingsdown Medical Consultants, Ltd. v. Hollister, Inc., 863

F.2d 867, 874, 9 USPQ2d 1384, 1390 (Fed. Cir. 1988) (“[N]or is it in any manner improper to amend or insert claims intended to cover a competitor's product the applicant's attorney has learned about during the prosecution of a patent application.”)

A test for determining whether later claimed subject matter is supported by an earlier written description is whether the disclosure of the application “reasonably conveys to a person skilled in the art that the inventor had possession of the claimed subject matter at the time of the earlier filing date.” Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); Ralston Purina Co. v. Far-Mar-Co., Inc., 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985); In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). However, the written description requirement “is not subsumed by the ‘possession’ inquiry.” New Railhead Manufacturing LLC v. Vermeer Manufacturing, Co., 298 F.3d 1290, 1296, 63 USPQ2d 1843, 1847 (Fed. Cir. 2002). As noted by the Federal Circuit:

A showing of “possession” is ancillary to the statutory mandate that “[t]he specification shall contain a written description of the invention,” and that requirement is not met if, despite a showing of possession, the specification does not adequately describe the claimed invention. After all, as indicated above, one can show possession of an invention by means of an affidavit or declaration during prosecution, as one does in an interference or when one files an affidavit under 37 C.F.R. § 1.131 to antedate a reference. However, such a showing of possession alone does not cure the lack of a written description in the specification, as required by statute.

Enzo Biochem, Inc. v. Gen-Probe Inc., 296 F.3d 1316, 1330, 63 USPQ2d 1609, 1617 (Fed. Cir. 2002).

The specification must provide information that clearly allows persons having ordinary skill in the art to recognize that the applicant invented the later claimed subject matter. Vas-Cath, 935 F.2d at 1563-64, 19 USPQ2d at 1117; In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). The written description requirement is satisfied by the applicant’s disclosure of “such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.” Lockwood, 107 F.3d at 1572, 41 USPQ2d at 1966. The written description must show that the applicant invented each feature that is included as a claim limitation and the adequacy of the written description is measured from the face of the application. New Railhead,

298 F.3d at 1296, 63 USPQ2d at 1847. Put another way, one skilled in the art, reading the original disclosure, must reasonably discern the limitation at issue in the claims. Crown Operations International, Ltd. v. Solutia Inc., 289 F.3d 1367, 1376, 62 USPQ2d 1917, 1922 (Fed. Cir. 2002); Waldemar Link, GmbH & Co. v. Osteonics Corp., 32 F.3d 556, 558, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994). Additionally, a broadly drafted claim must be fully supported by the written description and drawings. Amgen, 314 F.3d at 1333, 65 USPQ2d at 1399.

In order to comply with the written description requirement, the specification “need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claimed.” All Dental Prodx LLC v. Advantage Dental Products, 309 F.3d 774, 779, 64 USPQ2d 1945, 1948 (Fed. Cir. 2002) quoting Eiselstein, 52 F.3d at 1039, 34 USPQ2d at 1470 (citing Vas-Cath, 935 F.2d at 1563, 19 USPQ2d at 1116, and In re Wertheim, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976)). The failure of the specification to specifically mention a limitation that later appears in the claims is not fatal when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented. All Dental, 309 F.3d at 779, 64 USPQ2d at 1948; Eiselstein, 52 F.3d at 1039, 34 USPQ2d at 1470. While identity of the language of the specification and the added claims is not required, identity of the subject matter of the claims and that which is described, is necessary. New Railhead, 298 F.3d at 1296, 63 USPQ2d at 1847. “What is claimed by the patent application must be the same as what is disclosed in the specification . . . .” Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722, \_\_\_, 122 S.Ct.1831, 1840, 62 USPQ2d 1705, 1712 (2002).

Although specifically claimed features need not be expressly described, the fact that the feature may be enabled is not alone sufficient to provide a written description for that feature. The description requirement is separate from the enablement requirement of § 112, ¶ 1. Enzo Biochem, 296 F.3d at 1323, 63 USPQ2d at 1612, Vas-Cath, 935 F.2d at 1563, 19 USPQ2d at 1117 (reinforcing the long-recognized severability of the “written description” and “enablement” provisions of § 112, ¶ 1); In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984). The Court of Customs and Patent Appeals suggested the following example to illustrate this point:

For greater clarity on this point, consider the case where the specification discusses only compound A and contains no broadening language of any kind. This might very well enable one skilled in the art to make and use compounds B and C; yet the class consisting of A, B and C has not been described.

In re Di Leone, 436 F.2d 1404, 1405 n.1, 168 USPQ 592, 593 n.1 (CCPA 1971). See also Martin v. Mayer, 823 F.2d 500, 505, 3 USPQ2d 1333, 1337 (Fed. Cir. 1987) quoting Jepson v. Coleman, 314 F.2d 533, 536, 136 USPQ 647, 649-50 (CCPA 1963) (“It is not a question of whether one skilled in the art might be able to construct the patentee’s device from the teachings of the disclosure [but] whether the application necessarily discloses that particular device.”).

Similarly just because a limitation would have been obvious from the disclosure does not mean it was described. A disclosure that merely renders the later-claimed invention obvious is not sufficient to meet the written description requirement; the disclosure must describe the claimed invention with all its limitations. Tronzo v. Biomet, Inc., 156 F.3d 1154, 1158, 47 USPQ2d 1829, 1832 (Fed. Cir. 1998); Lockwood, 107 F.3d at 1572, 41 USPQ2d at 1966.

## II.

Wakalopulos specifically argues:

Bilstad’s application claims 57-65, as well as the count, call for a sterilization apparatus comprising a “moveable member manipulating objects in a plurality of directions within the reactive volume wherein the manipulated objects are sterilized.” Such a moveable member, capable of manipulating objects in a plurality of directions within the reactive volume, is not described or disclosed in the Bilstad application.

Paper 21, pp. 5-6, emphasis original. The challenged claim language is somewhat different in each of Bilstad’s involved independent Claims 57, 62 and 65. Bilstad Claim 57 requires:

a moveable member [capable of] manipulating objects in a plurality of directions within the reactive volume wherein the manipulated objects are sterilized.

Bilstad Application 09/294,964, Paper 15, p. 10. Claim 62 requires:

at least one moveable member [capable of] manipulating objects in a plurality of directions in the reactive volume wherein manipulated objects are sterilized.

Bilstad Application 09/294,964, Paper 15, p. 12. Lastly Claim 65 states:

an automated moveable member for manipulating objects . . . in a plurality of directions within the reactive volume wherein the manipulated objects are sterilized

Bilstad Application 09/294,964, Paper 15, p. 13. Bilstad's dependent claims 58-61 (dependent on 57) and 63-64 (dependent on 62) do not affect the "plurality of directions" limitations.

Wakalopulos's motion addressed each of the portions of the written description which Bilstad identified as providing support for the "plurality" limitation when the involved claims were introduced to the prosecution before the examiner (BX 1001) and in the annotated copy of the claims (Paper 15) submitted by Bilstad during the interference.<sup>11</sup> Paper 21, pp. 7-11. In Wakalopulos' view, each of the portions identified by Bilstad, either fails to provide any details as to the nature of the manipulation or the manipulations are unidirectional or linear rather than in a plurality of directions. Paper 21, pp. 7-11.

Bilstad opposes the motion identifying specific portions of Bilstad's written description and certain drawing figures as showing manipulation of objects in a plurality of directions. Paper 28, pp. 8-11.

### III.

#### A.

The meaning of the word "plurality" in the phrase "a moveable member manipulating objects in a plurality of directions" is central to resolving the written description issue.

Each party has proposed a definition for "plurality" which supports their particular view of the issue. Wakalopulos asserts that the word means a large number. Thus, Wakalopulos asserts:

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<sup>11</sup> With respect to a party whose application contains drawing figures and/or claims including means or step limitations, the Standing Order provides that

within **twenty-eight (28) days** of the date of the NOTICE DECLARING INTERFERENCE, the party is required to file (in addition to the paper required by § 20 of this STANDING ORDER) a separate paper containing a copy of the claims in which:

- (a) following each element recited in each claim, the drawing numbers corresponding to that element are inserted in bold in braces, e.g., { } and
- (b) following each means or step for performing a specified function are inserted in bold in braces { }, all structure, material or acts described in the specification corresponding to that means or step (by citation to the page(s) and line(s) of the specification and/or figure and item number of the drawings).

Paper 2, § 21, pp. 12-13.

“Plurality” is defined as “a large number; multitude.” See Exhibit 1003 (Definition of “plurality” as provided by Random House Webster’s Collegiate Dictionary).

Paper 21, pp. 6-7. Giving plurality this meaning, Wakalopoulos argues that Bilstad’s specification at best discloses members which manipulate objects in only a single direction. Bilstad, it is argued, fails to disclose members capable of manipulating objects in many directions. Paper 21, pp. 6-7.

On the other hand, Bilstad asserts that the term refers to any number greater than one.

The ordinary and customary meaning of the term “plurality” is “more than one.” This is one of the most widely used words in patent prosecution. The Federal Circuit has held absent support in the file history to show the contrary, the term plurality “means, simply, ‘the state of being plural.’” York Products, Inc. v. Central Tractor Farm & Family Center, 99 F.3d 1568, 1575, 40 U.S.P.Q.2d 1619, 1625 (Fed. Cir. 1996). The Court elaborated upon this definition five years later, when it held “that ‘plurality,’ when used in a claim, refers to two or more items, absent some indication to the contrary.” Dayco Products, Inc. v. Total Containment, Inc., 258 F.3d 1317, 1328, 59 U.S.P.Q.2d 1489 (Fed. Cir. 2001).

Paper 28, p. 15. Bilstad then takes this definition and attempts to show that the specification describes embodiments which fall within this definition:

A specific embodiment of the invention of Claim 57 is shown in Figures 1, 2, 3A-3D, and 5A-5B of the Bilstad application, and is described in the portions of that application that discuss these Figures. These different Figures are interrelated, and together illustrated members manipulating objects in a plurality of directions.

Paper 28, p. 8. For example Bilstad argues that the specification describes manipulating objects in three directions which is a “plurality” under Bilstad’s definition. Paper 28, pp. 17-18.

#### B.

We have not been directed to any evidence showing that “plurality” has an art accepted or understood meaning. Nor have we been directed to any portions of Bilstad’s specification which provides a application specific definition. In fact, the only place in Bilstad’s specification where the word appears is in the claims copied to provoke this interference. Thus, the ordinary meaning of the word controls. It is well settled that dictionaries provide evidence of a claim term’s “ordinary meaning.” Texas Digital Systems v. Telegenix, Inc., 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1818 (Fed. Cir. 2002), CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1366, 62 USPQ2d 1658,

1662 (Fed. Cir. 2002) (citing Rexnord Corp. v. Laitram Corp., 274 F.3d 1336, 1344, 60 USPQ2d 1851, 1855 (Fed. Cir. 2001)).

Webster's Third New International® Dictionary, Unabridged, defines "plurality" as:

- 1a: the state of being plural . . .
- b: the state of being numerous
- c: a large number or quantity : MULTITUDE.<sup>12</sup>

Webster's also includes this definition of "plural:" "relating to or consisting of or containing more than one."<sup>13</sup>

As is apparent from the Webster's definitions, the ordinary meaning of plurality encompasses both parties' proposed meanings. Therefore, we do not accept either party's proposed definitions because they are incomplete. Two may properly be referred to as a plurality and so may a large number. Thus, "plurality" connotes an indefinite numerical range. The range is bounded by two at the lower end and unbounded or infinite at the upper end. Thus, "plurality" is a generic word which encompasses within its meaning any number at least two or greater.

#### IV.

We hold, based on review of Bilstad's entire written description, that Bilstad only describes manipulating objects to be sterilized in a small number of directions. This description is not sufficient to support the phrase "manipulating objects in a plurality of directions." The addition of the term "plurality of directions" brings within the scope of Bilstad's claims apparatus including a member capable of moving objects in a large or even infinite number of directions. Bilstad's original specification does not provide a written description of manipulations in a large number of directions. In other words, we find that Bilstad does not have written descriptive support for the generic subject matter now claimed. A broadly drafted claim must be fully supported by the written description and drawings. Amgen, 314 F.3d at 1333, 65 USPQ2d at 1399. The description of a small number of species or examples does not necessarily provide support for generic language covering those species as well as other species. Tronzo, 156 F.3d at 1158-60, 47 USPQ2d at 1832-34 (The

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<sup>12</sup> Webster's Third New International® Dictionary, Unabridged, Copyright © 1993 Merriam-Webster, Inc.

<sup>13</sup> Webster's Third New International® Dictionary, Unabridged, Copyright © 1993 Merriam-Webster, Inc.



description of “conical shaped cups” insufficient written descriptive support for claims directed generically to “cups”); In re Lukach, 442 F.2d 967, 969, 169 USPQ 795, 797 (CCPA 1971) (single example of 2.6 does not alone provide written descriptive support for the claimed range from 2.0 to 3.0.) Bilstad’s original written description does not describe or convey possession of the invention of an apparatus of the scope covered by Bilstad’s copied claims. An apparatus capable of manipulating objects in a multitude of directions may or may not be enabled by or may or may not be obvious from the written description. However, the written description must actually describe the later-claimed invention, not just enable it or provide enough information to render it obvious. Tronzo, 156 F.3d at 1158, 47 USPQ2d at 1832; Lockwood, 107 F.3d at 1572, 41 USPQ2d at 1966; Martin, 823 F.2d at 505, 3 USPQ2d at 1337; DiLeone, 436 F.2d at 1405, 168 USPQ at 593.

## V.

Bilstad has argued in great detail how Bilstad’s written description describes a member manipulating objects in a plurality of directions. A key aspect of Bilstad’s argument is that the various parts of the Bilstad apparatus in combination form “a member” manipulating objects. For the purpose of this decision only, and without deciding whether this is a correct construction, we adopt Bilstad’s position. Thus, the combination of conveyor belt 22 shown in Figure 2 and clamps 70 and 71 shown in Figures 5A and 5B are considered to be “a member.”

Bilstad argues that

A specific embodiment of the invention of Claim 57 is shown in Figures 1, 2, 3A-3D, and 5A-5B of the Bilstad application, and is described in the portions of that application that discuss these Figures. These different Figures are interrelated, and together illustrate members manipulating objects in a plurality of directions.

Paper 28, p. 8. More specifically, Bilstad argues that manipulations in three directions are described by Bilstad Figures 1, 2, and 3. Paper 28, pp. 8-11. Bilstad supports the argument with the testimony of Prof. Colgate. B. Ex. 2009.

Bilstad seems to approach the written description issue backwards. Bilstad starts with the language of the copied claims, provides a definition of plurality, and then attempts to show that subject matter in the specification is allegedly encompassed by that definition. However, the description requirement inquiry must look to what the specification tells the person of ordinary skill,

i.e., what is described by the original specification. The subject matter described and the subject matter of the later added claims must then be compared. If the claimed subject matter is the same as the subject matter in the written description, it is described. "What is claimed by the patent application must be the same as what is disclosed in the specification . . . ." Festo, 535 U.S. at \_\_\_, 122 S.Ct. at 1840, 62 USPQ2d at 1712. Bilstad's written description must support the full scope of "a plurality of directions." A broadly drafted claim must be fully supported by the written description and drawings. Amgen, 314 F.3d at 1333, 65 USPQ2d at 1399. Bilstad's purported description of three directions is insufficient to describe the full scope of a plurality of directions.

Prof. Colgate's testimony is insufficient for the same reason. It is directed to showing that Bilstad's written description includes disclosure that falls within the scope of "a plurality," rather than showing that the written description conveys the full scope of the word plurality.

We also note that Prof. Colgate appears to testify that Bilstad's written description describes motion in more than three directions. He summarizes these in Paragraph 13 of his testimony:

13. In conclusion, I believe that there are several respects in which motion along a plurality of directions within the reactive volume is described in the '964 application. These include:

- a. Motion imparted by the conveyor of Figure 2 combined with joining/assembling motion as illustrated in Figures 3, 5, 6 and 8.
- b. (a) combined with additional motions necessary to bring components into alignment.
- c. (a) combined with additional motions necessary to "peel" away protective tabs.
- d. (a) combined with additional motions necessary to permanently deform (cut or seat) components.

B. Ex. 2009, p. 7, ¶ 13.

Subparagraph a appears to related to motions in three directions discussed above.

Subparagraphs b and d combine the three directions of subparagraph a with "additional motions necessary to bring the components into alignment" and "additional motions necessary to permanently deform (cut or seat) components. Bilstad has not directed us to the portions of Bilstad's written description which say what these alignment and deforming motions are. While these motions may or may not be obvious or enabled from the disclosure, this is inadequate as a written

description. Tronzo, 156 F.3d at 1158, 47 USPQ2d at 1832; Lockwood, 107 F.3d at 1572, 41 USPQ2d at 1966.

Subparagraph c relates to Bilstad's Figures 5A and 5B and specifically to the four protective tab members designated 72 and 73, which hold the ends 14 of the objects to be joined. As the clamps 70 and 71 move towards each other the tab members peel away to expose the ends to be joined. Bilstad Application 09/294,964, Paper 1, Specification, p. 8. While the peeling of the tabs may be complex, Prof. Colgate does not explain how the peeling provides a manipulation of the object to be sterilized in a direction additional to the three directions provided by paragraph a. Prof. Colgate's testimony appears to describe movement of the member rather than the objects. Figures 5A and 5B only shows movement of the objects in directions towards each other.

Thus, Prof. Colgate's testimony does not establish that Bilstad's original specification describes the additions directions asserted.

## VI.

We note that the decision to copy Wakalopulos's claims was Bilstad's alone. Bilstad chose this approach to provoking an interference rather than relying on its own claims and asserting that the parties each claimed subject matter patentably indistinct from the other. It is applicant's burden to precisely define the claim. In re Morris, 127 F.3d 1048, 1055-56, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997). An interference exists when each party has a claim which is directed to the same patentable invention as an opponent's claim. 37 CFR § 1.601(j). A party's claim is directed to the same patentable invention as an opponent when the claim would have been anticipated by or obvious from an opponent's claim assuming the opponent's claim to be prior art. 37 CFR § 1.601(n). Thus, for an interference to exist it is not necessary for the parties to have identical or nearly identical claims. Indeed, an interference may exist where there is no common embodiment claimed by the parties. See e.g., Aelony v. Arni, 547 F.2d 566, 192 USPQ 486 (CCPA 1977) (an interference held to exist between a claim to a method using cyclopentadiene as a dienophile and a claim to a method using butadiene, isoprene, dimethylbutadiene, piperylene, anthracene, perylene, furan and sorbic acid; as the dienophile the claims were held to be directed to the same patentable invention even though they did not overlap in scope). In choosing to copy claims rather than relying on subject

matter which was clearly supported, Bilstad ran the risk that the copied claims would be held to lack written descriptive support in its specification.

Wakalopulos Preliminary Motion 1 is granted.<sup>14</sup>

## **FINAL JUDGMENT**

This interference was provoked by Bilstad based upon claims which have been held not to be supported by a written description. Bilstad has not filed a motion under 37 CFR § 1.633(c)(2) pursuant to § 1.633(i) to add claims to the Bilstad application that were both supported by the Bilstad application and interfere with Wakalopulos's claims. Morris, 127 F.3d at 1055-56, 44 USPQ2d at 1029. Thus, Bilstad lacks standing to prosecute this interference. Interferences are to be conducted "to secure the just, speedy, and inexpensive determination of every interference." 37 CFR § 1.601. It would be inconsistent with this goal to continue an interference where the provoking party does not have written descriptive support for that party's involved claims. It is, therefore, appropriate to terminate the interference with a final judgment at this time without addressing the parties' other preliminary motions.

## **ORDER**

It is

**ORDERED** that judgment on priority as to Count 1, the only count in this interference, is awarded against junior party ARNOLD C. BILSTAD, BRADLEY H. BUCHANAN, ALAN W. MARTILLA and ARCHIE WOODWORTH;

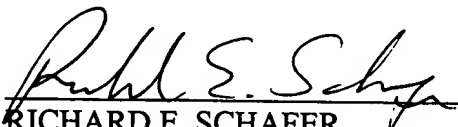

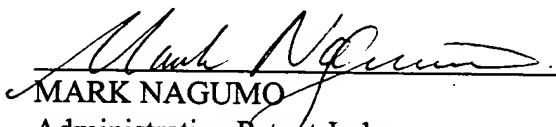
**FURTHER ORDERED** that junior party, ARNOLD C. BILSTAD, BRADLEY H. BUCHANAN, ALAN W. MARTILLA and ARCHIE WOODWORTH, is not entitled to a patent containing Claims 57-65 of Application 09/294,964;

**FURTHER ORDERED** that if there is a settlement agreement and it has not already been filed, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661; and

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<sup>14</sup> In reaching our decision, it was unnecessary and we have not considered Wakalopulos Reply 1 (Paper 49) on § 112, ¶ 1, issue.

**FURTHER ORDERED** that copies of this decision be given appropriate paper numbers and entered into the file records of Patent 6,140,657 and Application 09/294,964.

	)	
RICHARD E. SCHAFER	)	
Administrative Patent Judge	)	
	)	
RICHARD PORCZON	)	BOARD OF PATENT
Administrative Patent Judge	)	
	)	APPEALS AND
MARK NAGUMO	)	
Administrative Patent Judge	)	INTERFERENCES

cc (via Federal Express):

Attorney for BILSTAD:

Daniel N. Christus, Esq.  
311 S. Wacker Drive  
Suite 5300  
Chicago, IL 60606

Fax: 312-554-3301

Attorney for WAKALOPULOS:

Edward J. Lynch, Esq.  
COUDERT BROTHERS, LLP  
600 Beach Street, 3<sup>rd</sup> Floor  
San Francisco, CA 94109

Fax: 415-409-7400